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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91216571
Party	Defendant Benchmark Young Adult School, Inc.
Correspondence Address	DEBORAH A. GUBERNICK CALL & JENSEN 610 NEWPORT CENTER DR STE 700 NEWPORT BEACH, CA 92660-6498 dgubernick@calljensen.com;jbrownell@cal
Submission	Answer
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Attachments	benchmark opposition.pdf(38822 bytes)

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3. Applicant denies the allegations in this paragraph to the extent it seeks a legal conclusion of “concurrent” use. Applicant admits that it has used its mark in nationally in commerce in connection with addiction-recovery related services. Applicant lacks sufficient information concerning Opposer’s use and on such grounds denies the remaining allegations in this paragraph.

4. Applicant denies the allegations in Paragraph 4 of the Notice of Opposition.

5. Applicant denies the allegations in Paragraph 5 of the Notice of Opposition.

6. Applicant denies the allegations in Paragraph 6 of the Notice of Opposition.

7. Applicant denies the allegations in Paragraph 7 of the Notice of Opposition.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 8 of the Notice of Opposition and therefore denies same.

9. Applicant denies the allegations in Paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations in Paragraph 10 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

Without admitting or acknowledging that Applicant bears any burden of proof as to any of them, Applicant asserts the following non-exclusive affirmative defenses.

FIRST AFFIRMATIVE DEFENSE

(Priority)

Opposer is precluded from bringing this Opposition based on Applicant’s prior, superior rights by virtue of use in commerce.

SECOND AFFIRMATIVE DEFENSE

(Failure to State a Claim)

Opposer has failed to allege facts sufficient to state a claim upon which relief can be granted.

THIRD AFFIRMATIVE DEFENSE

(Lack of Standing)

1 Opposer has failed to allege grounds sufficient to establish its standing to maintain the
2 opposition.

3 FOURTH AFFIRMATIVE DEFENSE

4 (Distinctiveness)

5 The Opposition is barred because Applicant's mark has been used in commerce in connection
6 with the relevant goods for years without ceasing, resulting in a distinctive mark and trademark rights
7 associated therewith.

9 FIFTH AFFIRMATIVE DEFENSE

10 (Arbitrary Mark)

11 The Opposition is barred because Applicant's mark is arbitrary with respect to the services,
12 resulting in a strong and enforceable mark.

14 SIXTH AFFIRMATIVE DEFENSE

15 (Non-Generic)

16 The Opposition is barred because Applicant's mark is not generic with respect to the services,
17 resulting in a strong and enforceable mark.

19 SEVENTH AFFIRMATIVE DEFENSE

20 (Release, Waiver, and Estoppel)

21 The Opposition is barred by the doctrines of release, waiver, and estoppel for which a
22 reasonable opportunity for investigation or discovery is likely to provide evidentiary support.

24 EIGHTH AFFIRMATIVE DEFENSE

25 (Good Faith)

26 Any and all acts alleged to have been committed by Applicant were performed in good faith.

28 NINTH AFFIRMATIVE DEFENSE

(Restriction)

Applicant reserves its right to restrict its application and/or registration.

TENTH AFFIRMATIVE DEFENSE

(Improper Purpose)

On information and belief, Opposer's claims, in whole or in part, have been filed for an improper purpose and lack a reasonable and good faith basis in fact, specifically to gain leverage in a pending lawsuit between the parties in which Opposer is the defendant, and the known junior user of Opposer's mark. Opposer is guilty of inequitable conduct and comes to the Board with unclean hands. Opposer reserves the right to allege additional affirmative defenses as they may become known, or as they evolve during the litigation, and to amend this Answer accordingly.

ELEVENTH AFFIRMATIVE DEFENSE

(Reservation of Rights)

Applicant reserves the right to allege additional affirmative defenses as they may become known, or as they evolve during the litigation, and to amend this Answer accordingly.

WHEREFORE, Applicant prays that this Opposition proceeding be dismissed and that Applicant's application be allowed.

Respectfully submitted,

Dated: July 7, 2014

By: /Deborah A. Gubernick/
Deborah A. Gubernick

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER TO NOTICE OF OPPOSITION for Opposition No. 91216571 is being served on the Opposer via email and next day mail to:

Edward Patrick Swan, Jr.
Jones Day
12265 El Camino Real, Suite 200
San Diego, CA 92130
pswan@jonesday.com

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that this Certificate is executed on July 7, 2014.

/Tara Morgan/
Tara Morgan